

Application No.: 10/772,045

Case No.: 56165US011

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**Remarks**

We have amended claim 6 to independent form, and have added claims 7-10 dependent on claim 6 so that claims 1-10 are now pending.

**§ 112 Rejection**

The Examiner has rejected Claim 6 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement, suggesting that the claim 6 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner indicated an inability to find support in the specification for the language "having two projecting surface portions disposed at an angle with respect to each other", and requested that applicant either point out the passages in the original specification that support that language of claim 6 or cancel that language from the claim.

The Examiner's attention is directed to page 23, line 18 through page 27, line 16 of the specification that describes formation of an intersection or pattern portion illustrated in Figures 19 through 22 of the drawing that is formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from those adjacent closely spaced end surfaces. As can be seen in Figure 22, the closely spaced end surfaces of the four display lengths 502a, 502b, 502c, and 502d of decorative film each have two projecting surface portions 208-211, 209-210, 214-212, 215-213 disposed at an angle with respect to each other. As is stated in the paragraph on page 27, lines 10 to 17,

"The opposed end surface portions 208-212, 210-214, 209-213, 211-215 of the end portions 204a, 204b, 205a and 205b on the display lengths 502a, 502b, 502c, and 502d are cut to fit together to give a desired appearance for the intersection 220. Angles  $\alpha$  and  $\alpha'$ , which are both  $45^\circ$  as illustrated (so that the end surface portions on each end portion are disposed at  $90^\circ$  with respect to each other) may be changed for a desired appearance of the intersection. For example, angle  $\alpha$  may be  $30^\circ$  and angle  $\alpha'$  may be  $60^\circ$ , or other combinations of angles for  $\alpha$  and  $\alpha'$  may be used." (Note,  $\alpha'$  is seen on Figure 22, and  $\alpha$  is seen on Figures 19 and 20.)

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Thus, the subject matter of claim 6 was not new matter, but was described in the specification in a way that would clearly convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

### § 103 Rejections

The Examiner has rejected Claims 1-6 under 35 USC § 103(a) as being unpatentable over Sundet (#5,665,446) in view of Futhey (#5,840,407).

Sundet describes a laminate that can be adapted for use to decorate a substrate, which, like the laminate according to the present invention, comprises (1) a layer of pre-mask material comprising a cover layer and a layer of removable adhesive firmly adhered to one surface of the cover layer; (2) a plurality of decorative films each having a layer of adhesive along one of their major surfaces; and (3) a release liner with a first major surface adapted to be releasably adhered to by the removable adhesive on the cover layer and by the adhesives on the decorative films. Also, as in the laminate according to the present invention, the decorative films of Sundet are applied to the first surface of the release liner in a pattern, and the layer of removable adhesive included in the layer of pre-mask material is adhered over the outer major surfaces of the decorative films adhered to the release liner and to the release liner around the decorative films.

Unlike the laminate according to the present invention, however, the decorative films or "graphics" in the laminate of Sundet are each formed in one piece by cutting them from a large sheet of the film material as with a computer controlled knife or a die cutter and then removing the weed from around the decorative films (see column 5, lines 33-41 of Sundet). Thus the decorative films have shapes such as the W illustrated in Figure 1 of the drawing in Sundet.

In contrast, the laminate adapted for use to decorate a substrate according to the present invention includes a plurality of display lengths of decorative film tape each comprising a length of decorative film having opposite parallel edge surfaces, opposite end surfaces at opposite ends of the length of decorative film, opposite major surfaces extending between said edge and end surfaces, and a layer of adhesive along one of the major surfaces; which display lengths of decorative film tape have different lengths and shapes of their end surfaces formed by a computer operated tape applicator and are applied to the first surface of the release liner by that tape

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applicator with end surfaces of some of the display lengths closely spaced from each other to form a decorative pattern.

There is no teaching or suggestion in Sundet to form graphics from such lengths of tape having parallel side surfaces by placing ends of the lengths of tape closely together.

The Examiner has acknowledged this difference between the structure described in Sundet and the present invention by citing Futhey. Futhey et al describes lengths of decorative film tape of a type that can be used in the claimed laminate. Applicants acknowledge that such lengths of decorative film tape were well known prior to the present invention, and that such lengths of decorative film tape have been used to decorate substrates particularly including glass substrates. There has, however, been no laminate of the type claimed that includes such lengths of decorative film tape formed and applied by a computer operated tape applicator in combination with the claimed pre-mask material and release liner.

Thus, the laminate adapted for use to decorate a substrate according to the present invention as claimed in claim 1 is not made obvious by a combination of Sundet and Futhey. Claim 1 should be allowed.

Claims 2 through 5 are dependent on claim 1 and are thus allowable for all of the reasons given above with respect to claim 1. Also, those dependent claims recite structural features that are not taught or suggested by the cited art in the combinations claimed. For example:

Claim 3 recites that lengths of decorative film have grooves or other structure along the major surface of the decorative film opposite the layer of adhesive so that the decorative film visually simulates a decorative structure. As noted above, the cited art does not teach or suggest a laminate of the type claimed that includes such lengths of decorative film tape.

Claim 5 dependent on claim 1 recites that the decorative pattern in the laminate according to the present invention comprises a plurality of pattern portions, each of which pattern portions is formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from said adjacent closely spaced end surfaces, said closely spaced end surfaces of said four display lengths of decorative film each having two projecting surface portions disposed at a right angle with respect to each other. There is no teaching or suggestion of such pattern portions in any of the cited references. Under the

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"Response to Arguments" portion of the Office Action under reply the Examiner stated "on page 5, applicant argued that the "right angle" limitation of claim 5 renders it patentable over the prior art." While the structure claimed in claim 5 includes the "right angle" limitation noted by the Examiner, it is not that limitation, but the plurality of pattern portions, each of which pattern portions is formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from said adjacent closely spaced end surfaces that further patentably distinguishes the present invention as claimed in claim 5.

The use of the claimed plurality of pattern portions is important as it allows formation of many different decorative patterns with the lengths of decorative film in the laminate, two of which are illustrated in Figures 1 and 7 of the drawing.

As noted above, the Examiner has found no teaching or suggestion of the laminate as claimed in claim 1, and further has found no teaching or suggestion of the plurality of pattern portions of the type claimed in claim 5 in the claimed laminate so that those pattern portions further patentably distinguish the present invention from the cited art.

Claim 6, now in independent form, recites a laminate having the same structure as the laminate claimed in claim 5, except that the "right" angle limitation discussed by the Examiner has been removed. Thus claim 6 is allowable over the cited art for the reasons given above with respect to claim 5.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of all of the claims in the application are respectfully requested.

Respectfully submitted,

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Date

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